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Serial No. 10/613,900

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: John D. McEnroe Jr.	Docket No.: MCEJ101.CIP RPB REF: FENCE-0002
Serial Number: 10/613,900	Art Unit: 3625
Filing Date: July 2, 2003	Examiner: Michael Safavi
Title: CASTING FORM FOR A CAST-IN-PLACE STRUCTURAL ELEMENT AND FENCING SYSTEM INCLUDING CAST-IN-PLACE STRUCTURAL ELEMENTS	

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Office Action dated April 21, 2005, applicant hereby elects from Group I, the species encompassed by Figure 5; from Group II, the species encompassed by Figures 40-42; from Group III, the species encompassed by Figure 2, all without traverse.

It is not clear from this somewhat unusual Election requirement whether the Examiner is agreeing to examine one species from each of the three groups, or whether a further restriction between the three groups is required. However, the presence of a

form paragraph on Page 2 of the Office Action indicating an election of an invention is required would seem to point toward the latter. If so, then applicant requests that Group I be examined first.

The Examiner also required a listing of all claims readable on the elected species. Note that the grouping of Species is of the Examiner's choosing, and thus applicant's grouping of claims is presented here only in an attempt to respond to the Examiner's request, and should in no way be construed as an admission that applicant necessarily agrees with the grouping of species, inventions, claims, or the like.

Moreover, it is difficult to classify the various aspects of the present invention separately, as various features tend to overlap into various embodiments. Nevertheless, applicant will make a best effort to comply with the Examiner's requirement. Note that applicant reserves the right to alter or change the grouping of the claims depending upon the language of the claims as amended, or upon further reflection and/or review.

Attached is a claim chart grouping the associated drawing Figures to the claims. Note that it is easier to assign a claim to

a drawing Figure than vice-versa. From this claim chart we glean the following, based upon the Examiner's grouping of the Figures:

1. Group I (suspension assembly) requires the Examination of all of claims 1-6, 10-11, 13-16, 28, and 29. Applicant's elected Figure 5 would encompass claims 1-3, 5, 10, 11, 13, 15, 28 and 29, with independent claims 1, 10, 28, and 29 generic.

2. Group II (connecting member) requires the Examination of all of claims 7-8, 17-19, 26, 28, and 29. However, this necessitates also the Examination of the underlying independent claims 1, 10, and 22, as well. Applicant's elected Figures 40/41/42 would encompass claims 22 and 26.

3. Group III (form shape) requires the Examination of claims 1-3, 7, 1, 11, 13, 17, 22, 23, 25, 28 and 29. Applicant's elected Figure 2 would encompass claims 1-3, 7, 10-11, 13, 17, 22, 23, 25, 28 and 29.

As seen here, applicant's preferred grouping of features is different than the Examiner's grouping of inventions and species. The shape of the forms (Examiner's group III) is not really specifically recited in any specific claim, and thus almost all the claims encompass this aspect of the invention. This dichotomy of

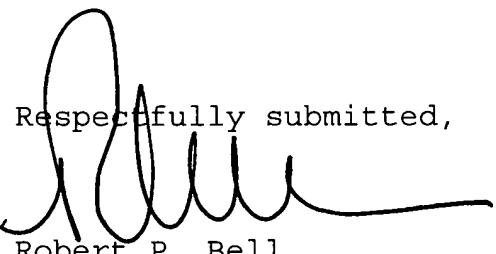
understanding is not to be unexpected, applicant and the undersigned have more exposure to the claim than the Examiner does at this point in the prosecution.

As a suggestion, and in line with the Examiner's election/restriction requirement, applicant submits that claims 1, 7-8, 10, 17-19, 22, 26, 28, and 29 be initially examined in the merits, as these claims reflect applicant's most successful commercial embodiment to date.

If these claims are deemed allowable, then dependent claims to applicant's other inventive features would be allowable as well. Fencing system claims 22-25 do not appear to include the limitation of a form support suspension assembly. However, applicant reserves the right to amend these claims to include such a feature.

Applicant appreciates that a number of different embodiments are presented herein. Applicant has been aggressively marketing and developing his product line, and as a result has come up with a number of different innovations and variations of his invention. The Examiner is encouraged to visit applicant's website www.fencebag.com to learn more about aspects of the invention as well as view pictures of the product in use as well as finished castings produced with the product.

Examination on the Merits is respectfully requested.

Respectfully submitted,

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